



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,185	08/23/2001	Charles W. Propst Jr	TPP 30482 A	9479

7590 12/22/2005
Thomas P Pavelko
Stevens Davis Miller & Mosher
Suite 850
1615 L Street NW
Washington, DC 20036

EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/914,185	Applicant(s) PROPOST JR, CHARLES W.	
	Examiner Christopher P. Bruenjes	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 December 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 5 and 7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 103 rejections of claims 5 and 7 over Shaw in view of Sugimoto of record in the Office Action mailed September 13, 2005, Pages 2-3 Paragraph 2, are withdrawn due to Applicant's arguments in the Paper filed December 13, 2005.

3. All of the rejections regarding claims 10-13, 15-18, and 20-22 are withdrawn due to Applicant's cancellation of the claims in the Paper filed December 13, 2005.

Claim Objections

4. Claim 5 is objected to because of the following informalities: In line 5, the comma after "composition" should be deleted and the word "and" should be added, in order to correct a grammatical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the limitation "the composition" in line 5 lacks antecedent basis. It is not understood if the limitation is referring back to the "polymeric composition" or the "intermediate composition".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

Art Unit: 1772

States and was published under Article 21(2) of such treaty in the English language.

8. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al (USPN 6,048,679).

Wang et al anticipate a support (see abstract), which is a paper layer (col.9, 1.2-5), is coated in direct contact with a film of conductive polymeric composition represented by the antistatic layer of Wang et al (see abstract). The polymeric composition is a dried layer formed from an intermediate composition comprising an aqueous solution (col.4, 1.66-67). The intermediate composition comprises a methyl methacrylate polymer base containing a quaternary ammonium compound (col.3, 1.27-61). The composition further comprises an ethylenically unsaturated monomer such as methyl methacrylate (col.5, 1.41-48). Note the limitation "in an amount of about 1 to about 10wt% based on the weight of the composition" is given its broadest reasonable interpretation. First, "the composition" is determined to be referring to the intermediate composition, which includes the water in the total weight. Second, "about" is not specifically defined in the specification. So it must be given its broadest reasonable interpretation in light of the specification. The specification teaches, especially in example 1 that the amount of quaternary ammonium compound is present in

Art Unit: 1772

the composition in an amount slightly less than 0.5wt%. The instant specification goes on to teach on page 5 that the examples 1 through 3 illustrate a conductive material being added in amount between about 1 to about 10wt%. Therefore, one of ordinary skill in the art would have recognized that the broadest reasonable interpretation of about 1wt% as defined in the specification includes amounts slightly less than 0.5wt%. In this case, Wang et al does not teach a specific range for the amount of quaternary ammonium compound in the coating solution, but does provide a specific example of 0.45% which is slightly less than 0.5wt%, which anticipates the claimed range of about 1wt% to about 10wt%. The composition further comprises a polyethylene wax (col.4, 1.34-54). The polymeric composition is deposited on said paper in an aqueous form and dried to form said film of polymeric composition (col.6, 1.24-37). The composition inherently imparts a static dissipative property and a conductive property to the paper layer because the antistatic layer formed of the composition of Wang et al is used to overcome the accumulation of static charges by providing the antistatic layer or electrically conductive layer (col.1, 1.60-63). Therefore, it inherently the layer provides static dissipative and conductive properties in order to perform its intended function and since the layer is formed of the same

Art Unit: 1772

materials as the claimed invention and the same composition must have the same properties.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al in view of Lu et al (USPN 5,130,177).

Art Unit: 1772

Wang et al teach all that is claimed in claim 5 as shown above, and teach that the antistatic layer or film containing a conductive polymeric composition is coated on photographic paper in order to impart antistatic protection to the photographic paper (col.1, 1.32-65). Lu et al also teach adding lubricant and antistatic layers to photographic paper (see abstract). Lu et al further teach that in addition to the quaternary ammonium compound and polymer base in the antistatic layer, additives such as pigments are added to provide the layer with a certain color. Lu et al specifically teaches adding zinc oxide as a suitable pigment to be employed within the aqueous dispersion prior to drying the coating (col.5, 1.1-10 and 1.36-50). One of ordinary skill in the art would have recognized that zinc oxide particles are added to the intermediate composition used to form an antistatic coating on photographic paper, in order to provide a certain color to the photographic paper, as taught by Lu et al. Furthermore, one of ordinary skill in the art would have recognized that Wang et al and Lu et al are analogous insofar as both references are concerned with forming photographic papers containing antistatic layers.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add an aqueous dispersion of zinc oxide particles to the

Art Unit: 1772

intermediate composition of the antistatic layer of Wang et al, in order to provide the photographic paper of Wang et al with a desired color, as taught by Lu et al.

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 5 and 7 over Shaw in view of Sugimoto have been fully considered but they are moot since the rejections have been withdrawn.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jugle (USPN 4,971,882); Fox et al (USPN 5,080,995); Agler et al (USPN 6,358,660); Williams et al (US 2003/0008116 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the

Art Unit: 1772

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772
CPB
CPB
December 20, 2005

Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

12/20/05